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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,911	02/25/2002	William R. Brosnan	IGT1P059/P-464	2680
22434	7590	03/25/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER

3713

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,911

Applicant(s)

BROSNAN ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/25/02 &amp; 8/19/03</u>   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Claim Objections*

1. Claims 5, 9, 11, 14, 16, 20-22, 25, 28-31 are objected to because of the following informalities:

a) In claim 5, line 2; claim 14, line 2; claim 25, line 1; claim 28-30, line 2, the claimed limitation "restricted credit" should be corrected to "the restricted credit".

b) In claim 9, line 2; claim 20, lines 1-2, the claimed limitation "wins of restricted credits to a player" should be corrected to "the wins of restricted credits to the player".

c) In claim 9, line 3; claim 20, line 2, claim 21, line 2; claim 22, line 2, the claimed limitation "game outcome" should be corrected to "the game outcome".

d) In claim 11, line 3, the claimed limitation "cashable or restricted credits" should be corrected to "said cashable or said restricted credits".

e) In claim 16, line 5, the claimed limitation "the game outcome" should be corrected to "a game outcome".

f) In claim 21, line 2, the claimed limitation "pay table at least" should be corrected to "pay table of at least".

g) In claim 31, line 2, the claimed limitation "the financial liability of the gaming machine" should be corrected to "a financial liability of a gaming machine".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 9, the phrase "something other than" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "something other than"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).
- b) In claim 12-13, the claimed limitation "said evaluation mechanism" lacks of antecedent basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (US Patent No. 5,816,918).

- a. As per claim 1, 6, and 14-15, Kelly discloses a gaming machine comprising an intelligent device for controlling a game play sequence for presenting a game on the gaming machine (col.

3, lines 11-13 and col. 6, lines 10-33). Further, since Kelly discloses awarding wins of restricted credits to a player based on previous game (col. 3, lines 13-16; col. 8, lines 24-28 and 31-34; col. 9, lines 21-23 and 34-36), and since using a memory for storing a game play history would have been well known, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a memory to the gaming machine of Kelly in order to facilitate recording game data.

- b. As per claim 2, Kelly discloses non-cashable restricted credits (Fig. 6c and col. 9, lines 7-14).
- c. As per claim 3-4, Kelly discloses an input and an output mechanism (col. 6, lines 34-50; col. 21, lines 15-30; and col. 11, lines 24-34).
- d. As per claim 5 and 10, providing cashable credit would have been well known to a person of ordinary skill in the art at the time the invention was made.
- e. As per claim 7, Kelly discloses interconnecting the game machine with other machines via a server (Fig. 3; col. 15, lines 45-46).
- f. As per claim 8, Kelly discloses including a printer (Fig. 1; col. 6, lines 10-14).
- g. As per claim 9 and 11, Kelly discloses providing restricted credits based on a selected criteria would have been obvious designed choice.
- h. As per claim 12-13, Kelly discloses associating a pay table to the evaluation mechanism (col. 25, lines 33-40 and col. 3, lines 57-58).
- i. As per claim 16, refer to discussion in claim 1 above. Further, Kelly discloses receiving a player wager and conducting the game (col. 14, lines 13-15).

- j. As per claim 17-20, refer to discussion in claims 2, 12-13 and 9 above.
- k. As per claim 21, determining game outcome based on a pay table of a bonus award would have been well known to a person of ordinary skill in the art at the time the invention was made.
- l. As per claim 22-24, refer to discussion in claims 10 and 6-7 above.
- m. As per claim 25, Kelly discloses using restricted credits as a wager (col. 20, lines 65-67 and col. 21, lines 1-6).
- n. As per claim 26-27, displaying available credits in cash denominations would have been well known.
- o. As per claim 28-30, Kelly discloses converting restricted credit winnings to merchandise (col. 8, lines 54-61). Further, converting the restricted credit winnings to other known type of exchange such as discount face value, etc. would have been obvious design choice.
- p. As per claim 31-32, refer to discussion in claims 1-2 above.
- q. As per claim 33-34, Kelly discloses providing winning based on a pay table (col. 25, lines 33-40 and col. 3, lines 57-58). Further, adjusting amount of winning would have been obvious design choice.

Art Unit: 3713

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read 'Kim Nguyen', with a stylized flourish at the end.

Kim Nguyen  
Primary Examiner  
Art Unit 3713

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Date: March 18, 2004